

REMARKS/ARGUMENTS

I. General

Claims 1-77 were pending in the application. In the present Office Action, claims 1-20, 22-70, and 72-77 are rejected and claims 21 and 71 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The outstanding issues in the present Office Action are:

- Claim 55 is objected to because of an informality;
- Claims 1, 54, and 62 are rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling;
- Claim 55 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention;
- Claims 1-10, 12-19, 22-38, 40-59, 61-69, and 72-77 are rejected under 35 U.S.C. § 102(e) as being anticipated by Published U.S. Patent Application Number 2002/0026452 A1 of Baumgarten et al. (hereinafter "*Baumgarten*"); and
- Claims 11, 20, 39, 60, and 70 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Baumgarten* in view of U.S. Patent Number 6,266,659 issued to Nadkarni (hereinafter "*Nadkarni*").

In response, Applicant respectfully traverses the outstanding claim objections and rejections, and requests reconsideration and withdrawal thereof in light of the amendments and remarks presented herein.

II. Claim Amendments

Claims 7, 54, and 55 are amended herein. No new matter is added by the claim amendments presented herein.

More specifically, claim 7 is amended herein to correct a typographical error therein by changing “communicative” to “communicate”. This amendment to claim 7 is not intended to narrow its scope in any manner but is instead intended merely as a cosmetic change for grammatical clarity.

Independent claim 54 is amended herein to recite “Computer executable program code stored to a computer-readable medium” (added language shown underlined). This amendment to claim 54 is not made for purposes of narrowing the claim to avoid prior art, but is rather made to ensure that claim 54 is directed to proper subject matter in accordance with M.P.E.P. § 2106.

Claim 55 is amended herein to correct an informality by changing “C1” to “54” such that claim 55 depends from independent claim 55. This amendment to claim 54 is not made for purposes of narrowing the claim to avoid prior art.

III. Objection to Claim 55

Claim 55 is objected to in the present Office Action for an informality. As noted by the Examiner in item 2 on page 2 of the Office Action, “claim C1” should read “claim 54”. As described above, Applicant has amended claim 55 herein to correct this informality, and therefore requests withdrawal of this objection.

IV. Claim Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 1, 54, and 62 are rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling. Applicant respectfully disagrees and asserts that the Examiner has failed to establish a reasonable basis for questioning the adequacy of the disclosure as required by M.P.E.P. § 2106, as discussed further below.

In rejecting claims 1, 54, and 62 under 35 U.S.C. § 112, first paragraph, the Examiner merely asserts "Creating a customized application program is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure." See Item 4 on page 2 of Office Action. However, to make a proper rejection under 35 U.S.C. § 112, first paragraph, the M.P.E.P. requires the Examiner to establish more than the Examiner has provided in the above sentence. For instance, M.P.E.P. § 2106.01 provides:

When basing a rejection on the failure of the applicant's disclosure to meet the enablement provisions of the first paragraph of 35 U.S.C. 112, the examiner must establish on the record that he or she has a reasonable basis for questioning the adequacy of the disclosure to enable a person of ordinary skill in the art to make and use the claimed invention without resorting to *undue experimentation*. (Emphasis in Original).

Further, for computer programming cases (such as the present application), M.P.E.P. § 2106.02 further provides:

To establish a reasonable basis for questioning the adequacy of a disclosure, the examiner must present a factual analysis of a disclosure to show that a person skilled in the art would not be able to make and use the claimed invention without resorting to undue experimentation.

Such a factual analysis of the disclosure has not been presented by the Examiner for the present application, and thus the Examiner has failed to establish a reasonable basis for questioning the adequacy of the disclosure of the present application. Accordingly, the Examiner has failed to make a prima facie case under 35 U.S.C. § 112, first paragraph.

Further, Applicant respectfully asserts that the disclosure is sufficiently enabling to satisfy the provisions of the first paragraph of 35 U.S.C. § 112. For instance, Applicant respectfully submits that the operational flow diagrams of FIGURES 3 and 4 and the corresponding discussions thereof in the specification of the present application provide sufficient disclosure for enabling the claimed invention under the first paragraph of 35 U.S.C. § 112.

In view of the above, Applicant respectfully requests withdrawal of the claim rejections under 35 U.S.C. § 112, first paragraph.

V. Rejection of Claim 55 Under 35 U.S.C. § 112, Second Paragraph

Claim 55 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As described above, Applicant has amended claim 55 herein to correct an informality by changing “claim C1” to “claim 54”, and therefore Applicant requests withdrawal of this rejection of claim 55.

VI. Claim Rejections Under 35 U.S.C. § 102(e) over *Baumgarten*

Claims 1-10, 12-19, 22-38, 40-59, 61-69, and 72-77 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Baumgarten*. Applicant respectfully traverses this rejection as discussed more fully below.

A. The Examiner Has Failed to Establish that the Relied Upon Teaching of *Baumgarten* is Prior Art Under 35 U.S.C. § 102(e)

First, Applicant questions whether the matter taught by *Baumgarten* is prior art to the present application under 35 U.S.C. § 102(e). The present application has a filing date of August 17, 2000. *Baumgarten* is a published U.S. patent application having a filing date of May 17, 2001, and claims the benefit of a provisional patent application having a filing date of May 17, 2000. The Examiner uses the date of the provisional patent application as the § 102(e) date of *Baumgarten*, which seems consistent with the *Examination Guidelines for 35 U.S.C. § 102(e)*, as amended by the *American Inventors Protection Act of 1999*, and further amended by the *Intellectual Property and High Technology Technical Amendments Act of 2002*, and 35 U.S.C. § 102(g) (see e.g., Section IV “Examination Procedures under 35 U.S.C. §§ 102(e) and 374” thereof).

However, Applicant respectfully submits that only the subject matter that was actually present in the provisional patent application is afforded the earlier date of May 17, 2000. For instance, the published U.S. patent application of *Baumgarten* having a filing date of May 17, 2001 may have matter included therein that was not present in the provisional patent application, and such new matter is not afforded the benefit of the filing date of the provisional patent application. M.P.E.P. § 201.11 explains that there are six conditions for

receiving the benefit of an earlier filing date under 35 U.S.C. § 119(e). The first requirement is that the “second application must be an application for a patent for an invention which is also disclosed in the first application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the first application and in the second application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112.” M.P.E.P. § 201.11, citing *Transco Prods., Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 U.S.P.Q.2d 1077 (Fed. Cir. 1994).

In the present Office Action, the Examiner has failed to provide Applicant with a copy of the provisional patent application and has failed to identify portions of such provisional patent application that include the teachings relied upon by the Examiner in making the rejections under 35 U.S.C. § 102(e). As such, Applicant is unable to evaluate whether the teaching of *Baumgarten* relied upon by the Examiner is actually prior art under 35 U.S.C. § 102(e) because such teaching of *Baumgarten* may not actually be present in the provisional but may instead be newly added matter in the published U.S. patent application (and therefore not be afforded the benefit of the provisional application’s filing date). Therefore, Applicant respectfully requests that the Examiner provide a copy of the provisional application and identify the portions of such provisional application that provide the teachings relied upon by the Examiner in making the above 35 U.S.C. § 102(e) rejection.

B. *Baumgarten* Fails to Teach All Elements of the Claims

Even if the teaching of *Baumgarten* relied upon by the Examiner is prior art under 35 U.S.C. § 102(e), without conceding that point, Applicant submits that the claims are not anticipated by *Baumgarten* because *Baumgarten* fails to teach each and every element of the claims. To anticipate a claim under 35 U.S.C. § 102, a single reference must teach every element of the claim, *see* M.P.E.P. § 2131. As discussed further below, *Baumgarten* does not teach every element of the rejected claims, and therefore fails to anticipate such claims under § 102(e).

For example, independent claim 1 recites, *inter alia*, “based on said desired hiring criteria of said employer, said computer program generating at least one customized application program that is executable to interact with candidates for employment with said employer” (emphasis added).

Independent claim 30 recites, *inter alia*, “a computer program executable by said processor-based device to receive as input desired hiring criteria of said employer and generate at least one application program, said at least one application program executable to interact with candidates” (emphasis added).

Independent claim 54 recites, *inter alia*, “code for presenting a user interface for receiving hiring criteria from an employer; and code for generating at least one qualification program for interacting with candidates” (emphasis added).

Independent claim 62 recites, *inter alia*, a business method comprising “allowing an employer access to a computer executable program, wherein said computer executable program enables said employer to generate at least one customized application program based on a desired hiring criteria of said employer; and allowing candidates access to the at least one generated customized application program” (emphasis added).

Baumgarten fails to teach or suggest at least the above limitations of independent claims 1, 30, 54, and 62. *Baumgarten* teaches an executive recruiting system as follows:

1) First, an employer contacts a recruiting firm with a job position that needs filling. *See* paragraph 31 and step 202 of FIGURE 2 of *Baumgarten*.

2) Next, the recruiting firm prepares an examination for potential candidates to identify those candidate not in possession of the required skills and knowledge for the listed position. The recruiting firm, in preparing the exam, relies on their experience and knowledge of filling comparable positions in the past and receives assistance from the employer as well. *See* paragraph 32 and step 204 of *Baumgarten*.

3) Next, the job description is posted on the web site to be accessible by candidates, or candidates access the web site to search the posted job listings, and a candidate may submit an indication of their interest in a posted position as well as a personal profile, wherein submitting the profile can be a multi-step process in which one of the steps in the completion of the exam prepared by the recruiting firm. *See* paragraphs 33-34 and steps 206 and 208

of *Baumgarten*.

4) Then, from the submitted profiles and exams, the recruiting firm can select candidates that appear to be well matched to the position. *See* paragraph 35 and step 210 of *Baumgarten*.

In view of the above, *Baumgarten* fails to teach a computer program generating at least one customized application program that is executable to interact with candidates for employment with an employer, as recited by independent claim 1, for example. Rather, *Baumgarten* teaches that the recruiting firm personnel prepares an examination for potential candidates to identify those candidate not in possession of the required skills and knowledge for the listed position. Thus, *Baumgarten* fails to teach or suggest at least the above-identified elements of independent claims 1, 30, 54, and 62.

Further, independent claim 1 recites “responsive to input from each of said candidates to the at least one generated customized application program, said at least one generated customized application program automatically determining whether each of said candidates qualifies for a position of employment with the employer” (emphasis added).

Similarly, independent claim 30 recites “said at least one application program executable to interact with candidates and determine whether each of said candidates qualifies for a position of employment with said employer” (emphasis added).

Independent claim 54 recites “code for generating at least one qualification program for interacting with candidates and determining whether each of said candidates qualifies for a position of employment with said employer” (emphasis added).

Independent claim 62 recites “responsive to input from each of said candidates to the at least one customized application program, said at least one customized application program automatically determining whether each of said candidates qualifies for a position of employment with the employer” (emphasis added).

Baumgarten fails to teach or suggest these further elements of independent claims 1, 30, 54, and 62. For instance, as described above, *Baumgarten* teaches that from the

submitted profiles and exams, the recruiting firm can select candidates that appear to be well matched to the position. See paragraph 35 and step 210 of *Baumgarten*. *Baumgarten* fails to teach or suggest a “generated customized application program automatically determining whether each of said candidates qualifies for a position of employment with the employer”, as recited by claim 1, for example. Rather, *Baumgarten* teaches that the recruiting firm personnel determines those candidates in possession of the required skills and knowledge for a listed position, as opposed to a customized application program (or “qualification program”) making such determination. Thus, *Baumgarten* fails to teach or suggest at least the above-identified elements of independent claims 1, 30, 54, and 62.

In view of the above, Applicant submits that *Baumgarten* fails to teach or suggest each and every element of independent claims 1, 30, 54, and 62, and therefore such independent claims are not anticipated under 35 U.S.C. § 102(e) by *Baumgarten*.

Further, dependent claims 2-10, 12-19, 22-29, 31-38, 40-53, 55-59, 61, 63-69, and 72-77 have been rejected under 35 U.S.C. § 102(e) as being anticipated by *Baumgarten*. In view of the above, Applicant respectfully submits that independent claims 1, 30, 54, and 62 are not anticipated under 35 U.S.C. § 102(e) by *Baumgarten* because *Baumgarten* fails to teach each and every element of such independent claims. Further, each of dependent claims 2-10, 12-19, 22-29, 31-38, 40-53, 55-59, 61, 63-69, and 72-77 depend either directly or indirectly from one of independent claims 1, 30, 54 and 62, and thus inherit all limitations of the respective independent claims from which they depend. It is respectfully submitted that dependent claims 2-10, 12-19, 22-29, 31-38, 40-53, 55-59, 61, 63-69, and 72-77 are allowable not only because of their dependency from their respective independent claims for the reasons discussed above, but also in view of their novel claim features (which both narrow the scope of the particular claims and compel a broader interpretation of the respective base claim from which they depend).

VII. Claim Rejections Under 35 U.S.C. § 103(a) over *Baumgarten* in view of *Nadkarni*

Dependent claims 11, 20, 39, 60, and 70 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Baumgarten* in view of *Nadkarni*. As discussed above, Applicant respectfully submits that independent claims 1, 30, 54, and 62 are of patentable merit over *Baumgarten*. Further, each of dependent claims 11, 20, 39, 60, and 70 depend either directly or indirectly from one of independent claims 1, 30, 54, and 62, and thus inherit all limitations of the respective independent claims from which they depend. It is respectfully submitted that dependent claims 11, 20, 39, 60, and 70 are allowable not only because of their dependency from their respective independent claims for the reasons discussed above, but also in view of their novel claim features (which both narrow the scope of the particular claims and compel a broader interpretation of the respective base claim from which they depend).

V. Conclusion

Claims 1-77 remain pending in the current application. As shown above, there are important differences between the claims and the applied art. Moreover, a person of ordinary skill in the art considering the applied art would not find these differences obvious. Accordingly, Applicant respectfully asserts that claims 1-77 are allowable over the applied art. Therefore, Applicant respectfully requests that these claims be passed to issue.

Applicant respectfully requests that the Examiner call the below listed attorney if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 59428/P001US/10020580 from which the undersigned is authorized to draw.

Attached is a version of the changes made to the specification and claims by the current amendment. The attached page is captioned "**Version with markings to show changes made.**"

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Respectfully submitted,

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Version With Markings to Show Changes Made

Claims 7, 54, and 55 have been amended as follows:

7. (Amended) The method of claim 6 wherein said user interface is a separate program executable to [communicative] communicate with said computer program.

54. (Amended) Computer executable program code stored to a computer-readable medium said code for generating customized programs for qualifying candidates for employment with an employer, said computer executable program code comprising:
code for presenting a user interface for receiving hiring criteria from an employer; and
code for generating at least one qualification program for interacting with candidates and determining whether each of said candidates qualifies for a position of employment with said employer.

55. (Amended) The computer executable program code of claim [C1] 54 wherein said code for presenting and code for generating are part of a common computer program.